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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,313	04/09/2002	Sharon May Armitage	1386/5 PCT	7941

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EXAMINER

GOLDBERG, JEANINE ANNE

ART UNIT

PAPER NUMBER

1634

DATE MAILED: 05/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding..

Office Action Summary	Application No. 10/069,313	Applicant(s) ARMITAGE ET AL.	
	Examiner Jeanine A. Goldberg	Art Unit 1634	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33,35,36,38,39,41,44-46,48-52 and 54-69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33,35,36,38,39,41,44-46,48-52 and 54-69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to the papers filed February 13, 2006.
2. Currently, claims 33, 35-36, 38-39, 41, 44-46, 48-52, 54-69 are pending.
3. All arguments have been thoroughly reviewed but are deemed non-persuasive for the reasons which follow.
4. Any objections and rejections not reiterated below are hereby withdrawn in view of the amendments to the claims.

Claim Objections

Claim 41 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 41 is directed to wherein the backing sheet is a release paper. Claim 33 however appears to contain this limitation by stating "a backing sheet releasably secured to the transparent polymeric sheet." It is unclear how, if, Claim 41 further limits Claim 33.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 35 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A) Claim 35 is indefinite in view of Claim 33. Claim 33 appears to require the structure contains a backing sheet releasably secured to the polymeric sheet. However, Claim 35 appears to be directed to the structure where the backing sheet has been removed and the polymeric sheet is secured to the base sheet. These two structures are not coextensive. Thus, it is unclear if and how Claim 35 can further limit Claim 33.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 33, 36, 41, 44-46, 48-52, 55-62, 65-66, 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Evident Crimescene (www.evidentcrimescene.com, Latent Fingerprint Recovery, April 27, 1999) in view of in view of Draper (US 6,007,104, December 28, 1999).

With respect to Claim 36 and the limitation that the structure contain instructions, the inclusion of instructions is not considered to provide a patentable limitation on the claims because the instructions merely represent a statement of intended use in the form of instructions in a kit. See In re Ngai, 367 F.3d 1336, 70 U.S.P.Q.2d 1862 (Fed. Cir. 2004)(holding that an inventor could not patent known kits by simply attaching new set of instructions to that product).

Evident Crimescene teaches Latent Fingerprint Recovery Supplies. The BVDA Hinge lifters which are illustrated on page 7. BVDA gellifters have a low-tack adhesive layer which is thick enough to lift complete prints from rough or polluted surfaces (BVDA manual, page 3). The transparent Gellifters have a clear polyester backing, the black and white have a backing of white rubberized linen. The transparent Gellifters have non-stick paper edges that provide a space for notations (BVDA manual, page 4). The Gellifters come in various sizes, however they can also simply be cut with scissors to a size that is needed to suit a particular job (page 4). As seen in the product information, all gellifters are protected by a transparent polyester film (page 2 of 6 from Gellifter Manual). The base sheet of either a polyester backing or rubberized linen would

dissolve in a solution (limitation of Claim 34). The Gellifter would allow a hole punch to remove a portion of the sample (limitations of claims 46, 44). The materials of the Gellifter would dissolve in an alkali or phenol/chloroform solution (limitations of Claims 45, 48). BVDA teaches gellifters may be use for a variety of different samples.

Evident does not specifically teach a bar code or other printed matter on a reverse surface of the base sheet with a releasably secured backing sheet.

However, Draper teaches a form of identification material is printed on the substrate. The identification material comprises a machine readable bar code and identification number specifically to identify the biographical data, insurance information, and instructions (col. 3, lines 45-55).

Ballard teaches a self-contained fingerprint kit which comprises releasably secured sheets. Ballard teaches the release sheet is used to cover an adhesive and may be readily removed to expose the adhesive (col. 4, lines 25-35).

Therefore, it would have been prima facie obvious to the ordinary artisan at the time the invention was made to have modified structure taught by Evident to allow for the identification and automated identification of the structure by adding a barcode to the structure and to have used a release liner to protect the adhesive prior to use. The ordinary artisan would have used a bar code or other non-functional printed matter on the fingerprint structure to allow for identification of the source. Using a bar code allows for automated identification of the structure as taught by Draper. Further, utilizing a backing sheet for the Evident structure would protect the adhesive and allow for the use of permanent adhesive which when contacted to the base sheet could not be tampered

with. The releasable sheet, taught by Ballard would be readily removed to expose the adhesive on the Evident structures and subsequently allow the security of the samples collected.

6. Claims 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Evident Crimescene (www.evidentcrimesscene.com, Latent Fingerprint Recovery, April 27, 1999) in view of Draper (US 6,007,104, December 28, 1999).

As noted above, if the polymeric sheet is irreversibly adhered together with the base sheet, the backing sheet is not present. Therefore, it is unclear the structure of Claim 35 and whether it further limits Claim 33.

Evident Crimescene teaches Latent Fingerprint Recovery Supplies. The BVDA Hinge lifters which are illustrated on page 7. BVDA gellifters have a low-tack adhesive layer which is thick enough to lift complete prints from rough or polluted surfaces (BVDA manual, page 3). The transparent Gellifters have a clear polyester backing, the black and white have a backing of white rubberized linen. The transparent Gellifters have non-stick paper edges that provide a space for notations (BVDA manual, page 4). The Gellifters come in various sizes, however they can also simply be cut with scissors to a size that is needed to suit a particular job (page 4). As seen in the product information, all gellifters are protected by a transparent polyester film (page 2 of 6 from Gellifter Manual). The base sheet of either a polyester backing or rubberized linen would dissolve in a solution (limitation of Claim 34). The Gellifter would allow a hole punch to remove a portion of the sample (limitations of claims 46, 44). The materials of the

Gellifter would dissolve in an alkali or phenol/chloroform solution (limitations of Claims 45, 48). BVDA teaches gellifters may be use for a variety of different samples.

Evident does not specifically teach a bar code or other printed matter on a reverse surface of the base sheet.

However, Draper teaches a form of identification material is printed on the substrate. The identification material comprises a machine readable bar code and identification number specifically to identify the biographical data, insurance information, and instructions (col. 3, lines 45-55).

Therefore, it would have been prima facie obvious to the ordinary artisan at the time the invention was made to have added a bar code to the structure taught by Evident to allow for the identification and automated identification of the structure.

Conclusion

7. No claims allowable.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Jeanine Goldberg whose telephone number is (571) 272-0743. The examiner can normally be reached Monday-Friday from 7:00 a.m. to 4:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla, can be reached on (571) 272-0735.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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The Central Fax Number for official correspondence is (571) 273-8300.

A handwritten signature in black ink, appearing to read "J. Goldberg". The signature is fluid and cursive, with the first letter "J" being particularly large and stylized.

Jeanine Goldberg

Primary Examiner

May 1, 2006